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REINHART BOERNER VAN DEUREN LTD.
483 NORTH MULFORD ROAD
SUITE 7
ROCKFORD, IL 61107

EXAMINER

KYLE, MICHAEL J

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| ART UNIT | PAPER NUMBER |
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3677

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/803,308

Applicant(s)

HORST ET AL.

Examiner

Michael J. Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 2,4,7,8,10,12,15,16,18 and 21-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6,9,11,13,14,17,19,20 and 30-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>7/16/04, 4/23/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

1. Claims 2, 4, 7, 8, 10, 12, 15, 16, 18, and 21-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 17, 2006. Examiner notes that in this election, applicant elected Species V, and asserted claim 12 to be readable on this species. Claim 12 claims a plurality of upward extending spikes on the upper surface of the central base member. This appears to be drawn to a non-elected species, for example, the species shown in figure 1. The elected species V, depicted in figure 9 has an adhesive on the upper surface of the base member, not spikes. For this reason, claim 12 is also withdrawn from consideration. It is further noted that claims 11 and 31 recite a “barb” on downwardly extending spike. While a barb is not shown in the elected species, examiner considers that when given its broadest reasonable interpretation, the outer surface of the threads meet the limitation of barb, in that they are pointed surfaces that extend backwards. Thus, claims 11 and 31, and elected by applicant, will be considered in this Office Action.

2. Applicant traverses the restriction on the grounds the examiner has not provided any reasons for the restriction. Examiner respectfully disagrees. Examiner refers to MPEP 808, titled “Reasons for Insisting Upon Restriction”. Under this heading, section 808.01(a) (“Species”) is included. Thus, the reason for the restriction is the distinct species claimed. A restriction is proper when there is a patentable difference between claimed species and there would be a serious burden on the examiner. In this case, the eight species are patentably distinct given their different physical structures. A serious burden results from having to search and

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examine eight different inventions in a single application. More specifically, a different search is required for each of the different structural characteristics on the upper surface of the central button member (i.e. spikes, adhesive, etc;).

3. Applicant argues that because examiner has addressed claim 1 as generic, that the examiner is required to examine all claims regardless of any election of species. Applicant has not provided any authority for this assertion and appears to have misconstrued the meaning of a generic claim. Only if a generic claim is held to be allowable, then all claims depending therefrom, regardless of species, are also considered allowable (MPEP 806.04(d)). A generic claim is a claim that is readable on all species. The mere fact that a claim is generic does not preclude a species restriction, as dependent claims can further limit the generic claim and provide for patentably distinct inventions, as is the case in the instant application.

Claim Objections

4. Claims 1, 30, and 34 are objected to because of the limitation “button-like”. It is unclear what limitations may be included by the term “like” that are not in the actually recited in the claim.

5. Claim 20 is objected to because of the limitation “the anchor tab”. This limitation lacks antecedent basis.

6. Claim 33 is objected to because of the limitation of “one or more gripping elements”. It is unclear to which feature this refers, as this terminology is not supported in the specification as originally filed. Additionally, it is unclear if these “gripping elements” are the same as the “torque-receiving elements” of claim 34. As best understood, they are. Examiner bases this

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understanding on the fact that both the gripping elements and torque receiving elements appear to serve that same function, and the lack of any description of gripping elements in the specification. Further, if these two elements are different elements, it is unclear how they would both be implanted on the same structure, as claim 34 depends from claim 33.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3, 11, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claim 1 limits the invention to an apparatus comprising a central base member and claims it for the intended use of securing a floor covering to an underlying substrate. Claims 3, 11, and 17 each positively recite limitations directed to the underlying substrate, which is not an aspect of the apparatus, but rather the environment in which the apparatus is used. It is unclear if the invention is drawn to the sub-combination of the apparatus itself, or the combination of the apparatus along with an underlying substrate. Presently, claim 1 is drawn only to the sub-combination apparatus. All limitations directed to any ancillary structure should be prefaced with “adapted to” or “for” language, to denote the intended use. If the combination is to be claimed, then claim 1 must be amended to clearly show this. For the purpose of this examination, only the sub-combination is being considered, and all limitations directed to the underlying substrate are being considered as intended use recitations.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3, 5, 6, 9 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2113993 (“GB ‘993”). GB ‘993 discloses an apparatus for securing a floor covering to an underlying substrate comprising a central base member (1) having an upper surface (5) that is adapted to engage a floor covering.

11. With respect to claims 3, 5, and 6, GB ‘993 discloses the apparatus to be capable of use with an underlying substrate having a layer of pile extending upward from a backing, and the central base member includes at least one downwardly extending spike (3) adapted to pass through the layer of pile and engage the backing (page 1, lines 120-128). The upper surface includes an adhesive that covered by a removable protective membrane (8).

12. With respect to claim 9, GB ‘993 shows a downwardly extending spike that is capable penetrating completely through the backing of an underlying substrate. Examiner notes that on page 2, lines 32-40, GB ‘993 discusses the possibility of the spikes being non-rounded, and the gripper being made of a rigid material. These characteristics would further enable the spike to penetrate through a backing.

13. With respect to claim 30, GB ‘993 discloses an apparatus comprising a central base member (1) having an upper surface adapted to engage a rug, and a single spike (3) capable of penetrating completely through a pile layer and backing. Examiner notes that as long as the prior

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art is capable of performing the claimed function (i.e. “penetrating completely through...”) then it is considered to meet the limitations of the claim. Additionally, because each spike (3) is an individual piece, each spike is considered to be a single spike.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 11, 13, 14, 17, 19, 20, and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB ‘993 in view of Carr (U.S. Patent No. 1,731,704). GB ‘993 fails to disclose a barb on the spike. Carr teaches a fastener including a central base member (B) and a downwardly extending spike (see Figures 2 and 5). The downwardly extending spike includes a barb in the form of a thread. Merriam-Webster’s Collegiate Diction 10th Edition defines a “barb” as “a sharp projection extending backward”. In this case, the outer surface of the thread is a sharp projection that extends backward. Carr uses this thread, or barb, to positively secure the fastener to the floor. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify GB ‘993 as taught by Carr, such that the spikes include a thread, or barb, which provides a positive fastening arrangement to more securely fasten the gripper to the floor.

16. With respect to claims 13 and 14, Carr discloses the central base member to include an adhesive (5) with a removable protective membrane (8).

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17. With respect to claim 17, GB '993 fails to show a thread on a single downwardly extending spike. Carr teaches a fastener including a central base member (B) and a downwardly extending spike (see Figures 2 and 5) having a thread. Carr uses this thread to positively secure the fastener to the floor. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify GB '993 as taught by Carr, such that the spikes include a thread, which provides a positive fastening arrangement to more securely fasten the gripper to the floor.

18. With respect to claims 19 and 20, Carr discloses the central base member to include an adhesive (5) with a removable protective membrane (8) that is peeled off for attachment of the anchor tab (6) to a lower surface of a floor covering.

19. With respect to claim 31, GB '993 fails to disclose a barb on the spike. Carr teaches a fastener including a central base member (B) and a downwardly extending spike (see Figures 2 and 5). The downwardly extending spike includes a barb in the form of a thread. Merriam-Webster's Collegiate Diction 10th Edition defines a "barb" as "a sharp projection extending backward". In this case, the outer surface of the thread is a sharp projection that extends backward. Carr uses this thread, or barb, to positively secure the fastener to the floor. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify GB '993 as taught by Carr, such that the spikes include a thread, or barb, which provides a positive fastening arrangement to more securely fasten the gripper to the floor.

20. With respect to claim 32, GB '993 fails to show a thread on a single downwardly extending spike. Carr teaches a fastener including a central base member (B) and a downwardly extending spike (see Figures 2 and 5) having a thread. Carr uses this thread to positively secure the fastener to the floor. It would have been obvious to one having ordinary skill in the art at the

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time of the invention to modify GB '993 as taught by Carr, such that the spikes include a thread, which provides a positive fastening arrangement to more securely fasten the gripper to the floor.

21. With respect to claims 33 and 34, Carr discloses gripping elements or torque receiving elements (inherent) to apply a torque to the apparatus. Without such elements, the threaded portion of Carr would not be able to be threaded into the floor. Thus, gripping or torque receiving element must necessarily be present in Carr to screw the threaded portion into the floor.

Information Disclosure Statement

22. The Information Disclosure Statements (IDS) of April 23, 2004, and July 16, 2004, have been noted. The two references under "Foreign Patent Documents" to Hearn (1511872) and Binder (1472729) have not been considered because it is not disclose by which foreign Office these references were issued.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references are cited to further show the state of the art with respect to fasteners: Fenton, Chisholm et al, Meyer, Stacavich-Notaro, Osada et al, and Akers.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Kyle whose telephone number is 571-272-7057. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

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25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mk


ROBERT J. SANDY
PRIMARY EXAMINER